Application/Control Number: 09/675,406   Docket No.: PALM-3506
Art Unit: 2179

REMARKS

Entry of the foregoing proposed Amendment and the following Remarks, along with reconsideration and allowance are respectfully requested.

Claims 1-25 remain pending. Applicants propose amending claim 17 to correct an error from the previous amendment. The proposed amendment to claim 17 does not change the scope of the claim.

Rejection of Claims 1-25

On page 3 of the Final Office Action, the Examiner rejected claims 1-25 under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent No. 6,516,202 to Hawkins et al. ("Hawkins") in view of U.S. Patent No. 6,408,176 to Urs. Applicants respectfully traverse the rejection.

Independent claim 1 is directed to a method of managing phone calls initiated from a computing device. The method includes, among other things, initiating a phone call in response to a dial signal, wherein the phone call is placed to a last entered phone number if digits were not received just before the dial signal was received from the call initiation button.

On page 4 of the Office Action, the Examiner admitted that Hawkins fails to disclose or suggest that a phone call is placed to a last entered phone number if digits are not received just before a dial signal is received from a call initiation button. The Examiner relied on Urs, at col. 3, lines 51-67, and col. 4, lines 1-20, to disclose this feature. Applicants respectfully disagree with the Examiner.

Urs, at col. 3, lines 51-67, and col. 4, lines 4-21, discloses:

Upon receiving the caller-related information, the communication unit 102 stores the caller-related information. Because the caller related information is resident in the communication unit 102, the user of the communication unit 102 can initiate a communication using the stored caller-related information at his or her convenience. Preferably, the user of the communication unit 102

8

Application/Control Number: 09/675,406   Docket No.: PALM-3506
Art Unit: 2179

initiates such a communication by selecting the caller-related information for viewing on the display 118 of the communication unit 102 and then pressing a key, button, or combination of keys and buttons on the keypad 120 of the communication unit 102. For example, the user might press the communication unit's "SEND" button while reading an SMS message containing the particular caller-related information desired for initiating the return call.

In an alternate embodiment, the converter device 112 may extract and convert the caller-related information in real-time as a voice mail message is received by the voice mail device 114. In this case, the converter device 112 conveys the caller-related information in alpha-numeric string format to the communication unit 102 without receiving any request for such information. The communication unit's receipt of the unrequested caller-related information would serve to notify the user of the communication unit 102 of voice mail received by the voice mail device 114 and immediately enable the user to initiate a communication using the caller-related information. Alternatively, the converter device 112 may extract and convert the caller-related information in real-time as a voice mail message is received, but then wait until a request is received for the caller-related information before conveying the caller-related information to the communication unit 102.

By initiating a communication using stored caller-related information as described above, a user of a communication unit can return a voice mail call, possibly multiple times, without having to write the telephone number down, memorize the telephone number, or dial the telephone number manually.

Thus, Urs discloses that when caller-related information (information that a user of a communication unit could use to initiate a communication in response to a voice mail message, see Urs, at col. 3, lines 21-25) is received, the communication unit stores the information. The user may then initiate a communication using the stored caller-related information at any time. Alternatively, a converter device may extract the caller-related information, in real time, from an incoming voice mail and may convert the caller-related information to an alphanumeric string. The communication unit may then wait until a request is received for the caller-related information and may then send the information to the communication device.

Applicants submit that the cited portions of Urs disclose that a user may return a phone call to a caller who left a voice mail without having to dial the number of the caller. However, the above-cited portions of Urs, relied upon by the Examiner, as well as any other

9

Application/Control Number: 09/675,406   Docket No.: PALM-3506
Art Unit: 2179

portions of Urs do not disclose or suggest that a phone call is placed to a last entered phone

number if digits are not received just before a dial signal is received from a call initiation

button, as required by claim 1. Therefore, Applicants submit that the Examiner failed to

make a proper *prima facie* case of obviousness.

According to MPEP, section 2143,

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

> The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicants submit, for that least the reasons discussed above, that neither Hawkins

nor Urs discloses or suggest, either separately or in combination, that a phone call is placed

to a last entered phone number if digits are not received just before a dial signal is received

from a call initiation button, as required by claim 1. Thus, at least the third criteria listed

above for establishing a *prima-facie* case of obviousness has not been met.

Further, on page 9 of the response filed on October 6, 2004, Applicants explained

that Hawkins, as well as Urs discloses using caller-related information to return a phone call

without the need to dial the callers phone number. For example, Hawkins, at col. 8, lines 9-
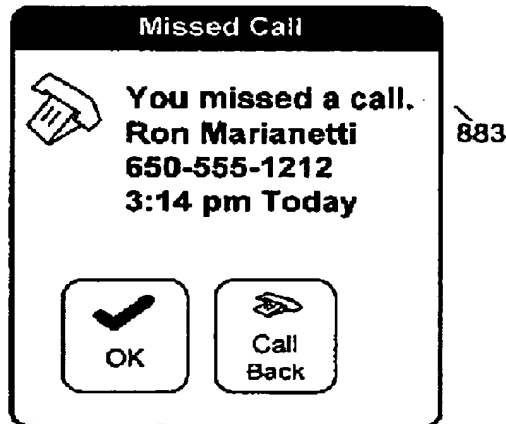
19 discloses:

> The user may chose [sic] to answer the call, by pushing the answer button, or ignore the call. For one embodiment, the answer button may be a software generated button. For one embodiment, the user may also accept or ignore the call by pushing a built-in button on the cellular element. If the user ignores the call, and voicemail is enabled on the system, the call is automatically transferred to voicemail. For one embodiment, if the user ignores the call, the call may be transferred to a user designated destination. A missed call screen 883 is displayed, showing the identity, telephone number, time and date of call. The user may acknowledge the missed call, or

10

Application/Control Number: 09/675,406   Docket No.: PALM-3506
Art Unit: 2179

may automatically return the call, if caller identification is enabled.
(*emphasis added*)

Display 883 of <u>Hawkins</u> is shown below.

Thus, one can easily see that <u>Hawkins</u> discloses returning a missed call by selecting "Call

Back" from a display, such as display 883, without a need for dialing a phone number.

The Examiner's suggested motivation for combining <u>Urs</u> with <u>Hawkins</u>, on page 3 of

the Office Action of May 6, 2004, is

> it would have been obvious to one of ordinary skill in the art at the time the
> invention was made to modify Hawkin's mobile computer to include a redial
> or call-previously-entered-phone-number features because it saves the user
> precious time (especially when the phone number that is being called is busy
> for a long time or when several continuous calls to the same number are
> necessary by enabling the caller to just press the SEND button over and over
> again until the call gets through.

Applicants respectfully disagree the Examiner because, as shown above, <u>Hawkins</u>, as well as

<u>Urs</u>, disclose a time saving way for returning a call by simply pressing a button and, as

explained previously, neither <u>Hawkins</u> nor <u>Urs</u> disclose or suggest, either separately or in

combination, a redial feature or a call-previously-entered-number feature.

Applicants note that, in response to Applicants' previous argument, of October 6,

2004, with respect to lack of motivation to combine the references, the Examiner, on page 2

11

Application/Control Number: 09/675,406   Docket No.: PALM-3506
Art Unit: 2179

of the Final Office Action of April 8, 2005, merely reiterated the features of each of the

references separately by stating:

> In this case, Hawkins discloses a personal digital assistance having a user
> interface that enables users to initiate a phone call in response to a dial signal;
> and Urs discloses a communication device that enables users to repeatedly
> initiate a cal [sic] without having to enter a caller-related information
> (telephone number) manually (abstract; col. 2, lines 39-44; col. 3, lines 1-67;
> col. 4, lines 1-2 1).

> Section 2142 of the MPEP states that:

> The initial burden is on the examiner to provide some suggestion of the
> desirability of doing what the inventor has done. "To support the conclusion
> that the claimed invention is directed to obvious subject matter, either the
> references must expressly or impliedly suggest the claimed invention or the
> examiner must present a convincing line of reasoning as to why the artisan
> would have found the claimed invention to have been obvious in light of the
> teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat.
> App. & Inter. 1985).

Applicants submit that, at least for the reasons mentioned above, the Examiner failed to meet

this burden.

Further, as argued above and on page 10 of the response of October 6, 2004, Urs does

not disclose or suggest initiating a return call using a last entered number. In response to this

argument, on page 3 of the current Office Action, the Examiner reiterated the features of Urs

by stating:

> Urs also discloses that "a user of a communication unit can return a voice mail
> call, possibly multiple times, without having to write the telephone number
> down. . . or dial the telephone number manually (col. 1, lines 23-33, 66-67;
> col. 2, lines 1-3, 39-44; col. 4, lines 5-10, 16-21).

Applicants wish to point out that, for at least the reasons discussed above, the above-

mentioned features emphasized by the Examiner have absolutely nothing to do with the

feature of initiating a phone call in response to a dial signal, wherein the phone call is placed

to a last entered phone number if digits were not received just before the dial signal was

received from the call initiation button, as required by claim 1.

In response to the arguments filed on October 6, 2004, on page 3 of the current Office

Action, the Examiner appeared to take Official Notice that:

Application/Control Number: 09/675,406   Docket No.: PALM-3506
Art Unit: 2179

> It is clear (and well known in the art) that the user is enabled to call the last
> dialed number without having to dial the number manually. It is well known
> in the art that users may dial the last dialed number by just pressing the
> "SEND" or "TALK" hard button.

Assuming *arguendo* that the above statement is true, although the Applicants do not concede

this point, the Examiner has still failed to provide a proper suggestion or motivation for

combining Hawkins with Urs. Therefore, all of the criteria for establishing a proper *prima*

facie case of obviousness are not satisfied.

For at least the reasons discussed above, Applicants submit that the rejection of the

claims in view of Hawkins and Urs is improper and respectfully request that the rejection of

claim 1 and dependent claims 2-9 be withdrawn.

Claim 10 is directed to a portable computing device having a phone capability and a

display. The computing device includes, among other things, a selection mechanism

configured to receive user selections from a selectable interface, wherein the selectable

interface includes a call initiation button that, when activated, initiates a phone call to a last

entered phone number if digits were not received just before a call initiation button is

activated.

Applicants submit that the above-mentioned feature of claim 10 is similar to the

previously-discussed feature of claim 1. Applicants submit that claim 10 and dependent

claims 11-16 are patentable over Hawkins and Urs for at least reasons similar to those

discussed with respect to claim 1. Therefore, Applicants respectfully request that the

rejection of claims 10-16 be withdrawn.

Claim 17 is directed to a computer-readable medium carrying one or more sequences

of one or more instructions for managing a phone call initiated from a computing device.

The one or more sequences of one or more instructions include instructions which, when

executed by one or more processors, cause the one or more processors to perform, among

other things, initiating a phone call in response to a dial signal, wherein the phone call is

13

Application/Control Number: 09/675,406   Docket No.: PALM-3506
Art Unit: 2179

placed to a last entered phone number if digits were not received just before the dial signal was received from the call initiation button.

Applicants submit that the above-mentioned feature of claim 17 is similar to the previously-discussed feature of claim 1. Therefore, Applicants submit that claim 17 and dependent claims 18-25 are patentable over Hawkins and Urs for at least reasons similar to those discussed with respect to claim 1. Therefore, Applicants respectfully request that the rejection of claim 17-25 be withdrawn.

Applicants further submit that claims 9 and 25 are also patentable over Hawkins and Urs for other reasons. Claim 9 depends from claim 1 as a base claim and further recites receiving an ended connection signal, and initiating a lapse time routine in response to receiving the ended connection signal. Similarly, claim 25 depends from claim 17 as a base claim and further recites receiving an ended connection signal, and initiating a lapse time routine in response to receiving the ended connection signal.

On page 6 of the current Office Action, the Examiner rejected claims 9 and 25 by stating, "Hawkins teaches a screen that provides the options of hanging up (ending connection), (col. 7, lines 42-44)." Applicants submit that neither Hawkins nor Urs disclose or suggest, either separately or in combination, initiating a lapse time routine in response to receiving the ended connection signal, required by claims 9 and 25. Further, the Examiner was completely silent regarding a prior art disclosure or suggestion of this feature. Because the Examiner failed to show that the prior art references teach or suggest the above-mentioned feature, Applicants submit that all criteria for establishing a proper *prima facie* case of obviousness have not been met.

14

Application/Control Number: 09/675,406   Docket No.: PALM-3506
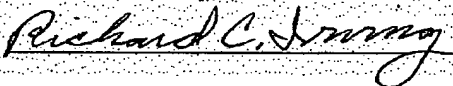Art Unit: 2179

CONCLUSION

Having addressed the rejection of claims 1-25, Applicants respectfully submit that the

subject application is in condition for allowance and a Notice to that effect is earnestly

solicited. If the Examiner does not agree that claims 1-25 are patentable, Applicants

respectfully request that the Examiner issue a non-Final Office Action due to the improper

obviousness rejections of the current Office Action and the Office Action of May 6, 2004.

The Commissioner is hereby authorized to charge any necessary fees (or credit any

overpayments) associated with this communication and which may be required to Deposit

Account No. 50-3102, referencing Attorney Docket No. PALM-3506.

Respectfully submitted,

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15